

1535
No. 11965.

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

LANE-WELLS COMPANY, a corporation,

Appellant,

vs.

M. O. JOHNSTON OIL FIELD SERVICE CORPORATION, a corporation,

Appellee.

M. O. JOHNSTON OIL FIELD SERVICE CORPORATION, a corporation,

Cross-Appellant,

vs.

LANE-WELLS COMPANY, a corporation,

Cross-Appellee

OPENING BRIEF FOR DEFENDANT- APPELLANT.

HARRIS, KIECH, FOSTER & HARRIS,
WARD D. FOSTER,

417 South Hill Street, Los Angeles 13,
Attorneys for Appellant-Cross-Appellee.

TOPICAL INDEX

	PAGE
I.	
Statement of jurisdiction.....	2
II.	
Statement of the case.....	3
A. The issues	3
B. The facts	8
(1) The patent in suit and the infringing apparatus.....	8
(2) Infringement is established if the doctrine applied by the court below is rejected.....	10
(a) The infringement of the claims of the Lane patent, if given the ordinary clear meaning of the words they employ, was repeatedly admitted by plaintiff	10
(b) The claims of the Lane patent were considered by the court to be infringed if given the ordi- nary clear meaning of the words they employ....	11
(c) The record establishes that the accused device contains all of the elements and performs all of the operations of the device defined by the claims in issue	11
III.	
Specification of errors.....	13
IV.	
Summary of argument.....	14
V.	
Argument	15
A. The doctrine of the decision of the District Court is con- trary to statutory law, an unjust extension thereof, and constitutes judicial legislation. The statutes define the prerequisites to the issue of a valid patent.....	15

B. The doctrine of the decision of the District Court is contrary to the intent of the constitutional provision authorizing the grant of letters patent.....	15
C. The doctrine of the decision of the District Court defeats the purpose of the existence of the United States Patent Office and renders futile the efforts of patent counsel and the expense of inventors in prosecuting and the care of the Patent Office examiners in determining the scope of patent claims to be allowed the inventor in a patent.....	17
D. The doctrine of the decision of the District Court renders uncertain to chaos the rights of a patentee and the privilege of others to use with immunity the invention of patentee	18
(1) What period of non-use shall determine the unenforceability and effective invalidity of the patent and the immunity of others to appropriate it?.....	18
(2) What circumstances shall affect the period of non-use making the patent unenforceable and in effect invalid and granting immunity to others appropriating its invention?	19
(3) How shall the circumstance of the patentee inventing ahead of his time affect the period of non-use determinative of the application of the doctrine of the District Court?	20
E. The doctrine of equivalents is not needed or applicable here	21
F. The doctrine of the decision of the District Court is contrary to the established law of this circuit.....	23
Conclusion	24

TABLE OF AUTHORITIES CITED


CASES

PAGE

American Valve & Meter Co. v. Fairbanks, Morse & Co., 249 Fed. 234	5
Claude Neon Lights, Inc. v. E. Machlett & Son, 36 F. 2d 574....	22
Crown Cork & Seal Co. of Baltimore City v. Aluminum Stopper Co. of Baltimore City, 108 Fed. 845.....	5
Johnston v. Woodbury, 109 Fed. 567.....	5
Manhattan Book Casing Mach. Co. v. E. C. Fuller Co., 204 Fed. 286	5
Reinharts, Inc. v. Caterpillar Tractor Co., 85 F. 2d 628.....	5, 6, 8, 23
Smith v. Snow, 294 U. S. 1, 55 S. Ct. 279, 79 L. Ed. 721.....	7
Western Telephone Mfg. Co. v. American Electric Telephone Co., 131 Fed. 75.....	5
World v. Thayer & Chandler, 148 Fed. 227.....	5

STATUTES

Judicial Code, Sec. 274-D (28 U. S. C., Sec. 400).....	2
Revised Statutes 4884 (35 U. S. C., Sec. 40).....	16
Revised Statutes 4886 (35 U. S. C., Sec. 31).....	15
Revised Statutes 4888 (35 U. S. C., Sec. 33).....	3, 15
United States Constitution, Art. I, Sec. 8, Clause 8.....	15



Digitized by the Internet Archive
in 2010 with funding from
Public.Resource.Org and Law.Gov

No. 11965.

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

LANE-WELLS COMPANY, a corporation,

Appellant,

vs.

M. O. JOHNSTON OIL FIELD SERVICE CORPORATION, a corporation,

Appellee.

M. O. JOHNSTON OIL FIELD SERVICE CORPORATION, a corporation,

Cross-Appellant,

vs.

LANE-WELLS COMPANY, a corporation,

Cross-Appellee

OPENING BRIEF FOR DEFENDANT- APPELLANT.

This is an appeal by Defendant-Cross-complainant-Appellant-Cross-appellee (hereinafter called Defendant) from final judgment entered by the District Court of the United States, for the Southern District of California, Central Division, holding that claims 7 to 9, inclusive, and 11 to 14, inclusive, of the Lane patent, No. 2,029,491, issued February 4, 1936, for Gun Type Formation Tester,

owned by the Defendant, have not been infringed by the manufacture, use, or sale by Plaintiff-Cross-defendant-Appellee-Cross-appellant (hereinafter called Plaintiff) of the apparatus exemplified by Defendant's Exhibits AH-1, AH-2, and AH-3, and granting an injunction prohibiting Defendant from threatening to sue or suing Plaintiff's customers, dealers, or sellers in infringement litigation with respect to said devices and said patent [Tr. 74-77].

I.

STATEMENT OF JURISDICTION.

The complaint sought declaratory judgment of invalidity and non-infringement of said Lane patent (and also the Spencer patent, No. 2,092,337, issued September 7, 1937, for Formation Testing Apparatus, and owned by Defendant) and asserted jurisdiction to be based on 28 U. S. C. 400 and 274-D, of the Judicial Code [Tr. 3].

The answer to the complaint admitted jurisdiction to be conferred by said sections.

The cross-complaint sought a judgment for infringement of the claims of said Lane patent, No. 2,029,491, and asserted jurisdiction of the Court to depend upon the Patent Laws of the United States [Tr. 30].

The answer to the counterclaim admitted that the jurisdiction of the Court with respect thereto depended upon the Patent Laws of the United States [Tr. 34].

II.

STATEMENT OF THE CASE.

A. The Issues.

The complaint and answer and counterclaim and answer therefor set forth the issues of:

(1) Infringement by the accused apparatus, Defendant's Exhibits AH-1, AH-2, and AH-3, manufactured and used by Plaintiff of claims 7 to 9, inclusive, and 11 to 14, inclusive, of the Lane patent, No. 2,029,491; and

(2) Validity of said claims of said Lane patent.

The Court held valid said claims of the Lane patent, and hence issue (2) above is not presented on this appeal of Defendant.

Findings 47 and 48 are to the effect that these claims of the Lane patent disclose a combination that is new [Tr. 62] and useful [Tr. 63]; conclusions of law 5, 6 and 7 establish that the Lane patent involved more than the work of mechanical skill and involved invention; that the Lane patent describes and claims the alleged invention with definiteness and specificity, R. S. 4888; and that claims 7 to 9, inclusive, and 11 to 14, inclusive, of said Lane patent are valid [Tr. 70].

Issue (1) above is the only issue presented by this appeal of Defendant.

Defendant's appeal is directed to the findings and judgment to the effect that said claims of the Lane patent are

not infringed by Plaintiff's accused apparatus, exemplified by Defendant's Exhibits AH-1, AH-2 and AH-3 [Tr. 71].

The only reason given in the Court's Conclusions of Law for finding non-infringement of the Lane patent claims by the accused devices is set forth in Conclusion 8:

"Inasmuch as the Lane patent in suit No. 2,029,491 was issued February 4, 1936, on an application originally filed in 1932, and no apparatus for practical use has ever been built and commercially used in accordance with it, the patent must be held to be of that class as to which there is no room for equivalents, and the claims thereof must be limited to the precise device shown in the patent; and so limited, plaintiff's accused apparatus, exemplified by defendant's Exhibits AH-1, AH-2 and AH-3, does not infringe the Lane patent in suit, or any of claims 7-9 inclusive, or 11-14 inclusive thereof." [Tr. 71-72.]

The doctrine of the District Court on this issue of infringement of the Lane patent was therefore, it is clear, that infringement of the claims was avoided only if and because the claims were construed as "Limited to the *precise* device shown in the patent" and would be so limited because no apparatus for practical use had been built and commercially used in accordance with such claims between the date of issue, February 4, 1936, and the filing of the complaint on April 10, 1947 [Tr. 11], a period of about ten years, except the accused apparatus built and commercially used by Johnston in January, 1946 [Tr. 395-96].

It is well established that patent drawings are merely illustrative of one example of an embodiment of the invention and are not working drawings and not to scale.

“The specification contains a detailed description, accompanied by drawings, exemplifying one form which the invention may assume. . . .”*

Reinharts, Inc. v. Caterpillar Tractor Co., 85 F. 2d 628, at 631 (C. C. A. 9, 1936).

“. . . But the drawings are not required to be working plans. They must be read in connection with the description and claims, and any inferences arising from omissions or inconsistencies in the drawings must yield to a legally sufficient specification. ‘Many material objects and operations,’ says Robinson (vol. 2, §491), ‘are so familiar to the inventor and his readers that their specific description, or even an allusion to them, would be superfluous. . . .’”

Western Telephone Mfg. Co. v. American Electric Telephone Co., 131 Fed. 75, at 77 (C. C. A. 7, 1904).

See also:

Manhattan Book Casing Mach. Co. v. E. C. Fuller Co., 204 Fed. 286, at 287 (C. C. A. 2, 1913);

World v. Thayer & Chandler, 148 Fed. 227, at 229 (C. C. A. 7, 1906);

Crown Cork & Seal Co. of Baltimore City v. Aluminum Stopper Co. of Baltimore City, 108 Fed. 845, at 849 (C. C. A. 4, 1901);

American Valve & Meter Co. v. Fairbanks, Morse & Co., 249 Fed. 234, at 239 (C. C. A. 7, 1917);

Johnston v. Woodbury, 109 Fed. 567, at 569 (C. C. A. 9, 1901).

*All underscoring throughout this brief is ours.

It is likewise well established that the specification of a patent need describe only one, and not necessarily the commercially best, embodiment of the invention, so long as it describes a structure embodying the invention operative for the intended purpose of the invention.

Referring to a patent upon a tractor, this Court of appeals held:

“Appellant contends that the tractor described in the Wickersham specification is a ‘frameless’ tractor, and that the accused tractor is not of that type and, therefore, cannot be said to infringe the Wickersham patent. This contention must fail. Wickersham’s invention is defined, not by the specification, but by the claims of his patent. Smith v. Snow, 294 U. S. 1, 11, 55 S. Ct. 279, 79 L. Ed. 721; Altoona Publix Theatres v. American Tri-Ergon Corporation, 294 U. S. 477, 487, 55 S. Ct. 455, 79 L. Ed. 1005; Continental Paper Bag Co. v. Eastern Paper Bag Co., *supra*, 210 U. S. 405, at page 419, 28 S. Ct. 748, 52 L. Ed. 1122. . . .”

Reinharts, Inc. v. Caterpillar Tractor Co., supra, at 633-34.

“ . . . But he is not confined to that particular mode of use since the *claims* of the patent, not its specifications, measure the invention. Paper Bag Patent Case (Continental Paper Bag Co. v. Eastern Paper Bag Co.), 210 U. S. 405, 419, 52 L. ed. 1122, 1128, 28 S. Ct. 748; McCarty v. Lehigh Valley R. Co., 160 U. S. 110, 116, 40 L. ed. 358, 361, 16 S. Ct. 240; Winans v. Denmead, 15 How. 330, 343, 14 L. ed. 717, 722. While the claims of a patent may incorporate the specifications or drawings by reference, see Snow v. Lake Shore & M. S. R. Co., 121

U. S. 617, 630, 30 L. ed. 1004, 1008, 7 S. Ct. 1343, and thus limit the patent to the form described in the specifications, it is not necessary to embrace in the *claims* or describe in the specifications all possible forms in which the claimed principle may be reduced to practice. It is enough that the principle claimed is exemplified by a written description of it. . . .”

Smith v. Snow, 294 U. S. 1, 55 S. Ct. 279, 79 L. Ed. 721, at 728 (1935).

It will be obvious to this Court that, if a patent is limited in its construction “to the precise device shown” in the specification and drawing of the patent, the patent can be avoided by anyone if a spring or lever is shown in the drawing and described in the specification and the appropriator uses a different kind of spring or a cam as a substitute for the lever, he avoids infringement.

Therefore, a construction of patent claims limiting them “to the precise device shown” in the specification and drawing of the patent is a holding of such unenforceability of the patent as to render it completely invalid for all effective purposes.

Clearly, therefore, a holding that the Lane patent or any patent shall be limited in the construction given its claims “to the precise device shown” in the specification and drawing of the patent, which is only an example of embodiments of the invention, is a holding of unenforceability of the patent, rendering it invalid for all practical purposes. The doctrine of non-use by the patentee of the subject matter of his patent, rendering the patent unenforceable, is therefore a doctrine that non-use by the patentee of the subject matter of his patent invalidates his patent.

This appeal is brought by the Defendant-Cross-appellant seeking to have this Court reject this doctrine of the decision of the District Court.

This Court has heretofore rejected the application of this precise doctrine by reversing the decision of a District Court which applied it, thus establishing the law of this Circuit to be that this precise doctrine shall not be applied.* The decision of the District Court in this case makes it necessary for this Court to again reject the doctrine that non-use of the patent limits its claims to the exact device illustrated and described in the patent, thus rendering the patent unenforceable and in effect invalid.

B. The Facts.

(1) The Patent in Suit and the Infringing Apparatus.

The Lane patent, No. 2,029,491, issued February 4, 1936, for Gun Type Formation Tester, is owned by the Defendant [Finding 4, Tr. 53], and claims 7 to 9, inclusive, and 11 to 14, inclusive, are in issue [Finding 77, Tr. 69].

Representative of these claims are claims 14 and 7:

“14. In combination; a packer for dividing a well bore into two zones; gun means connected with the packer for firing a projectile into the formation surrounding the well bore to open one of said zones to flow of fluids from said formation along the path formed by said projectile; and means for entrapping for withdrawal, fluid entering the perforated zone and having an intake passage connectible with said fluid receiving zone, said means adapted to be lowered

**Reinharts, Inc. v. Caterpillar Tractor Co.*, *supra*.

with said packer and gun means and forming a tool entity therewith.”

“7. In combination; a packer adapted when set to divide a well casing into upper and lower zones; and a gun means suspended from said packer in said lower zone; said gun means arranged to drive a projectile through the surrounding well casing.” [Tr. 483.]

The invention, an example of an embodiment of which is by way of illustration described in the specification and shown in the drawing, comprises the combination of a packer which can be set in an oil well casing to divide it into upper and lower zones with a gun assembled beneath the packer for perforating the casing and a formation testing device assembled in the unitary tool above the packer, so that, when the packer is set and the gun is operated and the casing perforated, the fluid from outside the casing may flow through the perforation and into the formation testing device.

The parts of the tool hereinbefore described are assembled as a unit, so that the tool may be lowered into the well and removed therefrom as a unit, avoiding the prior practice of lowering the gun alone in the casing, perforating the casing, withdrawing the gun from the casing, subsequently lowering a formation testing device and a packer to as nearly adjacent the perforation as the operator can, setting the packer, opening the formation testing device to entrap a sample, and withdrawing from the casing the formation testing device.

The embodiment of the invention set forth by way of example in the specification and drawings of the Lane patent leaves it to the operator to withdraw the sample entrapped in the formation testing device by such well known tools as bailers or such well known practices as employing

a liquid cushion above the sample before the packer is released and a bean or choke at the surface of the ground controlling the rate of flow [Finding 31, Tr. 58].

The use of such a combined tool as that shown by way of example in the specification and drawings of the Lane patent, as contrasted with the use of a formation tester and gun perforator separately, results in obtaining a formation sample such as could not be obtained using such tools separately [Finding 42, Tr. 61].

The Court below found the invention of the Lane patent to be a useful one [Finding 48, Tr. 63].

Plaintiff has manufactured and used such a combined gun perforator and formation tester as exemplified by Defendant's Exhibits AH-1, AH-2 and AH-3 [Finding 77, Tr. 69] since January, 1946 [Tr. 395-96], which contains all of these elements. The manufacture and use of such apparatus are asserted to infringe each of the above identified claims.

(2) Infringement Is Established if the Doctrine Applied by the Court Below is Rejected.

(a) THE INFRINGEMENT OF THE CLAIMS OF THE LANE PATENT, IF GIVEN THE ORDINARY CLEAR MEANING OF THE WORDS THEY EMPLOY, WAS REPEATEDLY ADMITTED BY PLAINTIFF.

Paragraph VII of the complaint recites:

"That in the event that claims numbered 7, 8, 9, 11, 12, 13 and 14 of Letters Patent No. 2,029,491 . . . are valid and interpreted and applied literally as worded, that the same can be read upon the Johnston Perforator and Formation Tester manufactured, operated and used by this plaintiff and would be infringed thereby." [Tr. 5].

This admission was repeatedly made by Plaintiff's counsel during the trial, an example thereof being as follows:

"The Court: If they are as broad as claimed and are valid [42] in that breadth, to that extent, you freely concede there has been infringement.

"Mr. Mellin: I think the court just put, in other words, exactly what I pleaded.

"Mr. Foster: That applies to both patents, Mr. Mellin?

"Mr. Mellin: Of course. [43]." [Tr. 98.]

- (b) THE CLAIMS OF THE LANE PATENT WERE CONSIDERED BY THE COURT TO BE INFRINGED IF GIVEN THE ORDINARY CLEAR MEANING OF THE WORDS THEY EMPLOY.

It follows from the fact that the claims of the Lane patent were held valid by the Court below [Finding 7, Tr. 70] that the lower Court considered it unnecessary to read or construe the claims in any other manner to avoid the prior art.

From this it follows that the only reason for the lower Court's construing the claims in a different manner and as "limited to the precise device shown" in the specification and drawings of the patent was to avoid a holding of infringement of such claims by the Plaintiff's devices.

- (c) THE RECORD ESTABLISHES THAT THE ACCUSED DEVICE CONTAINS ALL OF THE ELEMENTS AND PERFORMS ALL OF THE OPERATIONS OF THE DEVICE DEFINED BY THE CLAIMS IN ISSUE.

This is established by the testimony of Plaintiff's own witness O'Neill and was accepted by the Court below, for it ordered that:

"(1) The Findings of Fact and Conclusions of Law heretofore made are amended as follows: [84]

“(a) After Finding of Fact No. 19 add:

“—The following steps in the performance and use of the tool of the Lane patent in suit, No. 2,029,491, is described in such Lane patent, are identical with the steps in the performance and use of the Johnston accused tool as exemplified by Defendant's Exhibits AH-1, AH-2, and AH-3:

“1. The elements are assembled into a combined tool including a gun perforator, packer, and tester.

“2. The combined tool is lowered in the well to the point where it is desired to perforate.

“3. The gun is fired to perforate the casing.

“4. Several guns are fired successively.

“5. The drill pipe is rotated one turn to the left to unlatch the packer and set the slips.

“6. The weight of the drill pipe is lowered on the slips to set the packer.

“7. The drill pipe or tubing is open to the formation below the set packer.

“8. The entrance valve into the tool is left open until a sufficient quantity of the test liquids is secured in the tool.— [85]” [Tr. 78.]

It is clear, therefore, that, if the doctrine of limitation for non-use by the Court below be rejected and the claims of the Lane patent be construed in accordance with the ordinary and clear meaning of their terms, these claims are clearly infringed by the accused structure, and that the determination of whether such doctrine of non-use be applied is wholly determinative of the issue of infringement.

III.

SPECIFICATION OF ERRORS.

The asserted errors of the District Court that are relied upon by the Defendant are as follows:

(1) The District Court erred in limiting the claims of the Lane patent, No. 2,029,491, “to the precise device shown in the patent” [Tr. 70].

(2) The Court erred in finding and concluding no infringement by the manufacture and use of Plaintiff’s devices exemplified by Defendant’s Exhibits AH-1, AH-2 and AH-3, of claims 7 to 9, inclusive, and 11 to 14, inclusive, of the Lane patent, No. 2,029,491 [Finding 77, Tr. 69; Conclusion of Law 8, Tr. 75].

(3) The Court erred in not finding infringement by the manufacture and use of Plaintiff’s devices exemplified by Defendant’s Exhibits AH-1, AH-2 and AH-3 of claims 7 to 9, inclusive, and 11 to 14, inclusive, of the Lane patent, No. 2,029,491.

(4) The Court erred in rendering judgment of non-infringement by the manufacture and use of Plaintiff’s devices exemplified by Defendant’s Exhibits AH-1, AH-2 and AH-3 of claims 7 to 9, inclusive, and 11 to 14, inclusive, of the Lane patent, No. 2,029,491.

IV.

SUMMARY OF ARGUMENT.

A. THE DOCTRINE OF THE DECISION OF THE DISTRICT COURT IS CONTRARY TO STATUTORY LAW, AN UNJUST EXTENSION THEREOF, AND CONSTITUTES JUDICIAL LEGISLATION. THE STATUTES DEFINE THE PREREQUISITES TO THE ISSUE OF A VALID PATENT.

B. THE DOCTRINE OF THE DECISION OF THE DISTRICT COURT IS CONTRARY TO THE INTENT OF THE CONSTITUTIONAL PROVISION AUTHORIZING THE GRANT OF LETTERS PATENT.

C. THE DOCTRINE OF THE DECISION OF THE DISTRICT COURT DEFEATS THE PURPOSE OF THE EXISTENCE OF THE UNITED STATES PATENT OFFICE AND RENDERS FUTILE THE EFFORTS OF PATENT COUNSEL AND THE EXPENSE OF INVENTORS IN PROSECUTING AND THE CARE OF THE PATENT OFFICE EXAMINERS IN DETERMINING THE SCOPE OF PATENT CLAIMS TO BE ALLOWED THE INVENTOR IN A PATENT.

D. THE DOCTRINE OF THE DECISION OF THE DISTRICT COURT RENDERS UNCERTAIN TO CHAOS THE RIGHTS OF A PATENTEE AND THE PRIVILEGE OF OTHERS TO USE WITH IMMUNITY THE INVENTION OF PATENTEE.

(1) WHAT PERIOD OF NON-USE SHALL DETERMINE THE UNENFORCEABILITY AND EFFECTIVE INVALIDITY OF THE PATENT AND THE IMMUNITY OF OTHERS TO APPROPRIATE IT?

(2) WHAT CIRCUMSTANCES SHALL AFFECT THE PERIOD OF NON-USE MAKING THE PATENT UNENFORCEABLE AND IN EFFECT INVALID AND GRANTING IMMUNITY TO OTHERS APPROPRIATING ITS INVENTION?

(3) HOW SHALL THE CIRCUMSTANCE OF THE PATENTEE INVENTING AHEAD OF HIS TIME AFFECT THE PERIOD OF NON-USE DETERMINATIVE OF THE APPLICATION OF THE DOCTRINE OF THE DISTRICT COURT?

E. THE DOCTRINE OF EQUIVALENTS IS NOT NEEDED OR APPLICABLE HERE.

F. THE DOCTRINE OF THE DECISION OF THE DISTRICT COURT IS CONTRARY TO THE ESTABLISHED LAW OF THIS CIRCUIT.

V.

ARGUMENT.

A. The Doctrine of the Decision of the District Court Is Contrary to Statutory Law, an Unjust Extension Thereof, and Constitutes Judicial Legislation. The Statutes Define the Prerequisites to the Issue of a Valid Patent.

These requisites to patentability defined by the statutes of novelty, usefulness, and invention in the subject of the patent (R. S. 4886; 35 U. S. C. 31) and a full disclosure in the specification and a distinct claiming of the invention in the patent (R. S. 4888; 35 U. S. C. 33) are all of the prerequisites defined by any of the statutes.

To these five prerequisites the doctrine of this decision would add a sixth not required or suggested as necessary by any of the statutes, *i. e.*, use by the owner of the patent of the invention of the patent prior to the use of such invention by an appropriator.

B. The Doctrine of the Decision of the District Court Is Contrary to the Intent of the Constitutional Provision Authorizing the Grant of Letters Patent.

The constitutional provision under which all of the federal statutes on the subject of patents have been enacted is Article I, Section 8, Clause 8:

“The Congress shall have power . . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”

On the basis that, if every Congress which has legislated under this constitutional provision upon the subject of patents (a fact, so far as the writer of this brief can determine) understood this constitutional provision to mean that Congress, and Congress alone, should have the power to determine the extent of the limited time for which letters patent should be granted to secure to inventors their exclusive rights, it is urged that such was the intent of this provision of the Constitution.

If this be true, the Courts should not determine the extent of this limited time as did the Court below in applying its doctrine that non-use by the inventor rendered unenforceable and effectively invalid his patent short of the term prescribed by Congress.

Pursuant to this provision of the Constitution, Congress enacted a statute providing:

“Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery . . . throughout the United States and the territories thereof”

R. S. 4884, 35 U. S. C. 40.

The application of its doctrine of non-use by the Court below has as regards Defendant repealed this Federal statute by making the enforceability and effectively valid life of the Lane patent ten years instead of seventeen.

Such a doctrine and its application should be rejected by this Court.

C. The Doctrine of the Decision of the District Court Defeats the Purpose of the Existence of the United States Patent Office and Renders Futile the Efforts of Patent Counsel and the Expense of Inventors in Prosecuting and the Care of the Patent Office Examiners in Determining the Scope of Patent Claims to Be Allowed the Inventor in a Patent.

As this Court is well aware, applications for United States Letters Patent are usually pending for a number of years before the patent is issued. During this time, the applicant and his patent counsel and the examiners in the Patent Office are carefully studying the prior art to determine the precise scope of the claims to be contained in the issued patent to the end that the applicant for the patent shall be issued a patent, the claims of which cover all that he is entitled to under the statutory law and nothing more. When this has been determined after searches of the prior art by the Patent Office examiners, numerous amendments, and modifications of claims by the applicant, and sometimes conferences between applicant and his counsel and the examiners, the patent is issued with claims approved by the United States Patent Office as covering applicant's invention and no more.

If in accordance with the doctrine of the decision of the District Court here the scope of these issued claims so carefully framed and approved by the United States Patent Office are to be modified by a construction contrary to their plain terms because of non-use of the claimed invention by the patent owner, obviously, all of this effort, care, and expense by the United States Patent Office, the applicant, and his counsel are lost.

D. The Doctrine of the Decision of the District Court Renders Uncertain to Chaos the Rights of a Patentee and the Privilege of Others to Use With Immunity the Invention of Patentee.

The Lane patent issued February 4, 1936. Plaintiff commenced to make and use apparatus defined by the claims of the Lane patent in January, 1946, as conceded by Plaintiff [Tr. 98]. The complaint herein was filed April 10, 1946 [Tr. 11].

The Court held here that, because the owner of the Lane patent had not used commercially the invention of the patent from its date of issue to such latter dates, the doctrine that the claims would be revised and limited to the precise device illustrated and described in the patent by way of example should be applied.

If this doctrine be accepted by this Court, no patentee can tell the circumstances of non-use of his patented invention which render it unenforceable and in effect invalid; and no competitor can determine what period of non-use and circumstances affecting it are sufficient to enable him to appropriate the claimed invention with immunity.

(1) What Period of Non-Use Shall Determine the Unenforceability and Effective Invalidity of the Patent and the Immunity of Others to Appropriate It?

Here the period was ten years. If the period were eight years or two years, should the doctrine be applied? There is no guide for the determination of this question in the decision of the District Court, and patentees and potential infringers are left completely in the dark as to the period of non-use determinative of the application of the doctrine of the District Court if this Court accepts it.

(2) What Circumstances Shall Affect the Period of Non-Use Making the Patent Unenforceable and in Effect Invalid and Granting Immunity to Others Appropriating Its Invention?

Here the patent owner, during part of the non-use period, was in war work and, during all of such period, was building up a substantial business in an allied field.

Here a licensee was licensed at a substantial royalty rate prior to judgment herein [Tr. 688], and licensor collected substantial royalty from such licensee [Tr. 467-68].

If such circumstances are sufficient to make a period of non-use by the patentee of 10 years sufficient to render the patent unenforceable and in effect invalid, how much lesser period of non-use would be required for the application of the doctrine if these circumstances were not present?

If the patent owner had been in vital war work for the entire period of non-use, would the period of non-use sufficient for the application of the doctrine be less than the period here involved?

Had the patentee been unable because of lack of funds to commercially develop the invention of the patent, would the period of non-use sufficient for the application of the doctrine of the District Court be less or greater than the period here involved, and who can evaluate, interrelate, and determine the effect of these various and other pertinent factors?

Obviously, if the doctrine of the District Court be adopted by this Court, the answer is that only the District Court and this Court and the Supreme Court can determine the value and effect of all such circumstances

and related factors in determining the period of time for the application of the doctrine.

The patent owner cannot determine this in advance nor can the appropriator of the invention. Before the enunciation of this doctrine, the patentee could reasonably rely upon his right to enforce his patent during its full term of seventeen years, regardless of non-use by him. Before the application of this doctrine, the potential appropriator could reasonably determine that he could not with immunity appropriate the invention during the term of seventeen years of the patent as defined by statutory law, regardless of any non-use of the patent by its owner.

With the acceptance of this doctrine by this Court, patent owners and potential appropriators are deprived of this opportunity to establish with reasonable certainty the respective rights without taking the question through the Federal Courts.

(3) How Shall the Circumstance of the Patentee Inventing Ahead of His Time Affect the Period of Non-Use Determinative of the Application of the Doctrine of the District Court?

Obviously, some inventions are a great departure from the prior art and more revolutionary than others, and hence require more time after the issue of the patent for acceptance by the trade and public than such others.

Is such an inventor to be penalized? Is one inventor to be penalized over another, because his invention is more novel, inventive, and revolutionary than the other by having applied to his patent this doctrine of the District Court holding it unenforceable and in effect invalid because of a longer period of non-use than that of the other inventor?

This manifestly is unfair, and yet the acceptance of the doctrine of the District Court by this Court will make it necessary for the doctrine to be applied in this obviously unfair manner or for the Court to determine the degree of novelty, inventiveness, departure from the prior art, and revolutionary aspects of each invention and weigh this determination against all the other related circumstances and factors in determining the period of non-use which shall cause the doctrine of the District Court to be applied.

E. The Doctrine of Equivalents Is Not Needed or Applicable Here.

The lower Court found:

“Inasmuch as the Lane patent in suit, No. 2,029,-491, was issued February 4, 1936, on an application originally filed in 1932, and no apparatus for practical use has ever been built and commercially used in accordance with it, the patent must be held to be of that class as to which there is no room for equivalents . . .” [Finding 8, Tr. 71].

We urge that this finding that the application of the doctrine of equivalents avoided infringement is based upon a misconception of the lower Court that the doctrine of equivalents applies to narrow the language of a claim; whereas, in fact it applies only to enlarge the language of the claim to hold as an infringement a device having elements different from but equivalent to those contained in the claim.

It is submitted also that this finding was based upon a misconception that the equivalents to be found in the infringing device were equivalents of the elements described and illustrated in the specification and drawing

of the patent; whereas, the elements to be found in the infringing device must be equivalents of the elements set forth in the claims of the patent.

As said by Judge Learned Hand:

“ . . . The doctrine of equivalents, though well settled for many years, is anomalous, if the claim is measured only by its words, and for this reason we once went so far as to say that it means no more than that the language of claims shall be generously construed. *Motion Pictures Co. v. Independent Co.*, 200 F. 411 (C. C. A. 2). Such a limitation is however irreconcilable with those extremely numerous decisions which have extended a claim to structures which by no possibility it could cover, judged by any tenable canons of documentary interpretation. *Winans v. Denmead*, 15 How. 330, 343, 14 L. Ed. 717; *Blake v. Robertson*, 94 U. S. 728, 24 L. Ed. 245; *Clough v. Gilbert & B. Mfg. Co.*, 106 U. S. 166, 1 S. Ct. 188, 27 L. Ed. 134; *Royer v. Schultz Belting Co.*, 135 U. S. 319, 10 S. Ct. 833, 34 L. Ed. 214; *Hoyt v. Horne*, 145 U. S. 302, 12 S. Ct. 922, 36 L. Ed. 713; *Reece Button-Hole Mach. Co. v. Globe Button-Hole Mach. Co.*, 61 F. 958 (C. C. A. 1); *McCormick Harvesting Mach. Co. v. C. Aultman & Co.*, 69 F. 371 (C. C. A. 6); *McSherry Mfg. Co. v. Dowagiac Mfg. Co.*, 101 F. 716 (C. C. A. 6) . . . ”

Claude Neon Lights, Inc. v. E. Machlett & Son, 36 F. 2d 574, 575 (C. C. A. 2, November 11, 1929). (Rehearing, December 21, 1929.)

F. The Doctrine of the Decision of the District Court Is Contrary to the Established Law of This Circuit.

In the case of *Reinharts, Inc. v. Caterpillar Tractor Co.*, 85 F. 2d 628 (C. C. A. 9, 1936), there was made by the defendant the contention that the doctrine applied by the Court below should be there applied. In this contention the defendant had been successful in the Court below, and this Court reversed the decision on that ground. This Court held:

“Appellant says that the inventions covered by the Turnbull, Holt, Wickersham and Whitacre patents are ‘not in practical use.’ Therefore, appellant contends, these are ‘mere paper patents,’ and each of them ‘must be strictly limited to the structure as specifically described in its specifications and drawings’ . . .

“ . . . Furthermore, appellant’s proposition—that these patents, if not in practical use at the time of the trial, must be strictly limited to the structure specifically disclosed in their specifications and drawings—cannot be sustained. The authorities cited by appellant do not lay down any such rule. They merely hold that long-continued non-use of a patented invention may have a bearing on the construction to be given the patent, and that the courts, in construing such a patent, are not disposed to give it a broader scope than is clearly required. They do not hold that such a patent must be strictly limited to the specific structure disclosed in its specifications and drawings. Much less do they hold that a patent must be so limited, merely because of non-use at

the time of the trial. A patented invention, whether used or unused, is measured, not by the specifications and drawings, but by the claims of the patent. See authorities heretofore cited . . .” (p. 636.)

By this decision some thirteen years ago, this Court has established the law of this Circuit to be that non-use by the patent owner does not authorize a District Court to construe the claims of the patent as limited to the precise device specifically described in the specification and drawing of the patent. This law of the Circuit has continued for thirteen years. The decision below, here appealed from, is contrary to such established law and should be reversed.

Conclusion.

For the reasons and upon the evidence and the findings and the law hereinbefore set forth, Defendant respectfully submits that the judgment of the lower Court should be reversed as to Paragraph 7 [Tr. 75], Paragraph 9 in so far as it relates to the Lane patent, No. 2,029,491 [Tr. 76], and Paragraph 10 [Tr. 77]; that findings of fact and conclusions of law inconsistent with the striking and modifying of said judgment be likewise stricken or reversed, and that claims 7 to 9, inclusive, and 11 to 14, inclusive, of the Lane patent, No. 2,029,491, be held valid and infringed by the manufacture and use of devices exemplified by Defendant's Exhibits AH-1, AH-2, and AH-3.

Dated at Los Angeles, California, this 7th day of March, 1949.

HARRIS, KIECH, FOSTER & HARRIS,
WARD D. FOSTER,

Attorneys for Appellant-Cross-Appellee.